

REMARKS

Claims 1-21 are rejected under 35 U.S.C. 112 as failing to set forth the subject matter which the applicants regard as their invention.

The USPTO objects to the preamble including of a hardware component and a software component and reciting the hardware and software components along with a coordination component.

Applicants remind the USPTO that the preamble states that the system "includes" a hardware and software component. The system can therefore comprise other components because "includes" and "comprising" are open ended.

Independent claims 1 and 17 are however amended.

Independent claim 19 does not include the language referred to in the rejection, i.e. a coordination component, and therefore, claims 19-21 should not be included in this rejection. Withdrawal of this rejection is therefore respectfully requested with regard to the claims 19-21 for this reason.

The rejection of claims 1-21 under 35 U.S.C. 112 is submitted to be overcome.

Claims 1-13 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Universal Serial Bus Specification (Compaq, Intel, Microsoft, NEC Revision 1.1, September 23rd, 1998, and referred to as **USB** hereinafter). This rejection is not applicable to the claims as amended.

Independent claims 1, 17 and 19 include: the coordination component including a state machine and a state machine context store component, whereby links between the hardware component, the software component and the coordination component transfer inputs, directly and indirectly, between the hardware component, software component and the coordination component.

The PTO provides in MPEP §2131 that:

"[t]o anticipate a claim, the reference must teach every element of the claim."

Therefore, to support these rejection with respect to claims 1-13 and 16-21, the USB reference must contain all of the above-claimed elements of the claim. However, this reference does not disclose the coordination component including a state machine and a state machine context store component, whereby links between the hardware component, the software component and the coordination component transfer inputs, directly and indirectly, between the hardware component, software component and the coordination component.

As a result, the previous rejections based on 35 U.S.C. §102(b) cannot be supported by the USB reference as applied to claims 1-13 and 16-21.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over USB, and in view of Henry Milan et al (U.S. Patent No. 7,028,114 and referred to as Milan hereinafter). This rejection is not applicable to the claims as amended.

Claims 14 and 15 depend from claim 1 and are allowable for at least this reason.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the coordination component including a state machine and a state machine context store component, whereby links between the hardware component, the software component and the

coordination component transfer inputs, directly and indirectly, between the hardware component, software component and the coordination component.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests the coordination component including a state machine and a state machine context store component, whereby links between the hardware component, the software component and the coordination component transfer inputs, directly and indirectly, between the hardware component, software component and the coordination component.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claim(s) 1, 17 and 19 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1-21 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

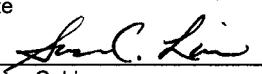


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